

REMARKS

Claims 1-20 are pending in this application. New claims 21-70 has been added. The Specification has been amended to update the filing dates and application numbers associated with the two co-pending related applications identified in the specification. Claims 1, 10, 18-20 have been amended, herein. No new matter has been added by way of this amendment. Applicants respectfully request reconsideration in view of the above amendments and the following remarks.

Claim Rejections – 35 U.S.C. § 101

The Office Action indicates that claims 1-20 have been rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Applicants respectfully submit that the amendments to independent claims 1, 10, 18-20 address this issue, per the Examiner's suggestion. Specifically, the term "computer system" has been added to further clarify aspects of the invention within the technological arts. Accordingly, Applicants request withdrawal of this ground of rejection.

Claim Rejections – 35 U.S.C. § 103

Claims 1-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Joao (U.S. Pat. No. 6,347,302), in view of Borghesi, et al. (U.S. Pat. No. 5, 950,169). Applicants respectfully traverse this rejection and request reconsideration in view of the following remarks.

Claims 1-9

Independent claim 1 recites, *inter alia*, “determining a class of items for which insurance is to be provided with a sale or lease of one of the class of items....” Applicants respectfully submit that neither Joao nor Borghesi, teaches or suggests providing insurance with a sale or lease of an item.

The Joao patent is directed to an apparatus and method for providing insurance to cover any damage or repairs for a leased item. The insurance disclosed in Joao protects a lessee from any repairs necessary beyond the ordinary wear and tear of the leased item either during or after the term of the lease. Specifically, in Col. 2, lns. 10-18, Joao:

provides an apparatus and a method for providing insurance products, services and/or coverage...for protecting individuals and/or business entities from liability which may arise as the result of excess wear and tear and/or damage which may occur to a leased and/or rented entity during the lease and...for protecting individuals and/or business entities from liability for post-warranty repairs.

The Joao patent simply teaches supplying insurance for a leased item. Joao does not teach or suggest, providing the insurance with a sale or lease of an item, as recited in claim 1.

The Borghesi patent does not teach or suggest anything that would remedy the deficiency discussed above with regard to Joao. Borghesi is directed to a computer database system for managing insurance claim processing. Claim processing occurs after a person seeks compensation for incurred damage by submitting a claim and also after the sale of a product or the initiation of a lease. Accordingly, Applicants respectfully submit that Borghesi’s claim processing management database does not teach or suggest providing insurance with a sale or lease of an item or paying the insurance, as recited in independent claim 1.

In contrast to both Joao and Borghesi, independent claim 1 recites, “determining a class of items for which insurance is to be provided with a sale or lease of one of the class of items....” Applicants respectfully submit that neither Joao’s method of providing insurance of a leased item, nor Borghesi’s claim processing management database, either alone or in combination, teach or suggest providing insurance with a sale or lease of an item. For at least this reason, Applicants submit that the independent claim 1, as well as claims 2-9, which are dependent therefrom, are patentably distinct from both Joao and Borghesi. Therefore, Applicants respectfully request withdrawal of this ground of rejection.

Claims 10-17

Independent claim 10 recites, *inter alia*, “providing, in a sales agreement relating to the sale or lease of the item, a confirmation of a provision of an insurance policy covering a loss relating to the item....” Applicants respectfully submit that for at least the reasons discussed above the cited patents do not teach or suggest providing an insurance policy as part of a sales agreement. Specifically, Joao’s method of simply providing insurance for a leased item and Borghesi’s claim processing management system, do not teach or suggest the limitation as recited in independent claim 10.

For at least this reason, Applicants submit that the independent claim 10, as well as claims 11-17 which are dependent therefrom, are patentably distinct from both Joao and Borghesi. Therefore, Applicants respectfully request withdrawal of this ground of rejection.

Claims 18-20

Independent claim 18 recites, *inter alia*, “receiving an indication of an item sold to a buyer for which insurance is provided by a third party...[and] charging a

premium....[wherein] the premium [is] based on a class of the item and geographic region of the buyer without consideration of further qualifications of the buyer.” Applicants respectfully submit that the cited patents do not teach or suggest receiving an indication that a third party provides a buyer with insurance for an item sold to a buyer. Further, Applicants submit that the cited references do not teach or suggest charging a premium that is solely based on a class of the item and the geographic region of the buyer, without considering other qualifications of the buyer.

The Office Action concedes that “Joao does not explicitly disclose receiving an indication of an item sold to a buyer for which insurance is provided by a third party; charging a premium for the insurance policy to the third party, the premium based on a class of the item and a geographic region of the buyer without consideration of further qualifications of the buyer.” (See Office Action page 9, paragraph 3.)

The Examiner alleges that receiving an indication of an item sold to a buyer for which insurance is provided by a third party is taught by Borghesi, in Col. 9, lines 18-67 to Col. 10, line 45. However, the cited passage in Borghesi simply details the various attributes of the claim processing management database, as well as listing searchable fields. Further, Column 10 in Borghesi merely discloses the determination of damages associated with a “total loss” of the leased vehicle. Borghesi teaches, “the user may send out a request for a specific total loss valuation from a third party provider.” (See Col. 10, lns. 26-28.)

With regard to charging a premium, wherein the premium is determined solely based on the class of item and the geographic region of the buyer, the Examiner alleges Col. 9, lines 7-67 in Borghesi teach this element. However, the cited passage details various elements of

the claim processing database ranging from administrative information, vehicle data, total loss information, events, estimates, totals, notes, correspondence, salvage, and rates. There simply is no teaching or suggestion in the cited passage that the premium is based on a class of the item and a geographic region of the buyer without considering further buyer qualifications, as recited in independent claim 18.

In contrast, independent claim 18 recites, “receiving an indication of an item sold to a buyer for which insurance is provided by a third party; [and] charging a premium for the insurance policy to the third party....” Applicants submit that Borghesi, which discloses insurance claim data entry fields and requesting a third party to determine a total loss value estimate, does not teach or suggest receiving an indication that a third party is providing insurance for an item sold to a buyer and charging a premium for the insurance policy to the third party, as recited in independent claim 18. Furthermore, Applicants submit the cited combination does not teach or suggest basing the premium on the class of item and the buyer’s geographic region without considering further buyer qualifications, also as recited in independent claim 18.

For at least these reasons, Applicants submit that the independent claim 18, is patentably distinct from both Joao and Borghesi. Therefore, Applicants respectfully request withdrawal of this ground of rejection.

Independent claim 19 recites, *inter alia*, “the premium being based on the class of items and the geographic region, without consideration of further characteristics of the buyer.” Applicants respectfully submit that for at least the reasons discussed above regarding independent claim 18 and the determination of the premium, independent claim 19 is patentably

distinct from both Joao and Borghesi. Therefore, Applicants respectfully request withdrawal of this ground of rejection.

Amended independent claim 20 recites, *inter alia*, “receiving a paid-up insurance policy for the item as part of the sales agreement....” Applicants respectfully submit that for at least the reasons discussed above regarding independent claim 1, the cited combination of patents are different from the elements of amended independent claim 20. Joao’s method of providing insurance for a leased item, either alone or in combination, with Borghesi’s claim processing management database do not teach or suggest receiving a paid-up insurance policy for an item as part of a sales agreement. Therefore, Applicants respectfully request withdrawal of this ground of rejection.

New Claims 21-70

Applicant have further added claims 21-70, which specifically recite features not found in any of the cited references.

CONCLUSION

It is now believed that all pending claims are in condition for allowance. In view of the amendments and remarks, an early and favorable reconsideration is respectfully requested.

Respectfully submitted,

MORGAN & FINNEGAN, L.L.P.

Dated: September 5, 2003

By: 

(Walter G. Hanchuk
Registration No. 35,179

Correspondence Address:
MORGAN & FINNEGAN, L.L.P.
345 Park Avenue
New York, NY 10154
(212) 758-4800 (telephone)
(212) 751-6849 (facsimile)